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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,009	02/08/2005	Derek Stewart Hunter Smith	CO/2-22734/MA 2225/PCT	9482
324	7590	11/29/2006	EXAMINER	
CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			GREEN, ANTHONY J	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/524,009

Applicant(s)SMITH, DEREK STEWART
HUNTER**Examiner**

Anthony J. Green

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6, 8, 10-13 and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Specification No. 10-60331.

The reference teaches, in the abstract and the machine translation, the use of ultrasonic treatment at a frequency of 20-50 kHz to treat pigment dispersions. See paragraph [0020] for the types of pigments that are useable in the process. As for the amount of solids, since water is used as the medium in the amount of 70-98% by weight [paragraph 0018] it is believed that the solids content would then range from 2 to 30% which falls within the instantly claimed range.

The instant claims are met by the reference. While the reference does not recite that the use of the ultrasonic treatment improves the rheological properties, this is

believed to be an inherent result absent evidence to the contrary since the process is the same.

4. Claims 1-3, 5-6, 8, 10-11, 13 and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by PCT International Application No. WO00/24679.

The reference teaches, the use of ultrasonic frequency waves of 16 to 100kHz to treat inorganic or organic pigment dispersions used in colourant formulations containing such dispersions (see the abstract, the examples and the claims). The pigment used in the examples is a naphthol pigment (Pigment Red 23). Page 3 recites the solids contents which range from 10% to 80%.

The instant claims are met by the reference. While the reference does not recite that the use of the ultrasonic treatment improves the rheological properties, this is believed to be an inherent result absent evidence to the contrary since the process is the same.

5. Claims 10-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese Patent Specification No. 63-304263A.

Instant claims 10 and 11 are product-by-process claims.

The abstract teaches, the use of ultrasonic treatment to produce a pigment dispersion.

While the reference does not teach the use of the same process conditions. (i.e. the frequency) as instantly claimed, it is the position of the examiner that the resulting product is the same. As stated in MPEP 2113 [R-1] "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). "The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). Accordingly since the product is believed to be the same, the instant claims are taught by the reference.

6. Claims 1-4, 6, 8, 10-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Specification No. 459967A2.

The reference teaches, in the abstract and the claims, and column 5, line 17, the use of ultrasonic treatment at a frequency of 10-40 kHz to treat pigment dispersions. See page 4, lines 46+ for the types of pigments that are useable in the process.

The instant claims are met by the reference. While the reference does not recite that the use of the ultrasonic treatment improves the rheological properties, this is believed to be an inherent result absent evidence to the contrary since the process is the same.

7. Claims 4, 7, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT International Application No. WO00/24679.

The reference was discussed above.

The instant claims are obvious over the reference. With respect to claim 4 while the reference does not teach the same inorganic pigments as instantly claimed it broadly teaches the use of inorganic pigments and accordingly any types would appear to be useable absent evidence showing otherwise. As for claims 7 and 14 these limitations appear to be matters of obvious choice or design and as such they are not seen to produce unexpected results. Further page 7 suggests various types of ultrasonic processes that may be utilized. With respect to claim 12 while the reference does not teach the same organic pigments as instantly claimed it broadly teaches the use of organic pigments and accordingly any types would appear to be useable absent evidence showing otherwise.

Art Unit: 1755

8. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Specification No. 10-60331.

The reference was discussed above.

The instant claims are obvious over the reference. As for claims 7 and 14 these limitations appear to be matters of obvious choice or design and as such they are not seen to produce unexpected results.

9. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Specification No. 459967A2.

The reference was discussed above.

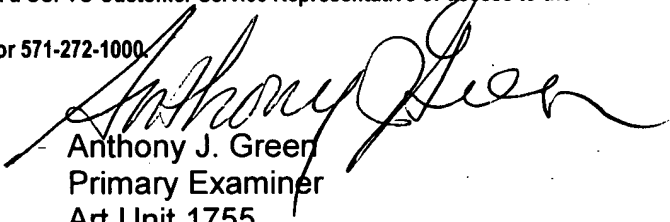
The instant claims are obvious over the reference. As for claims 7 and 14 these limitations appear to be matters of obvious choice or design and as such they are not seen to produce unexpected results. Further page 5, lines 17+ teach that the type of system used to produce the ultrasonic energy may vary, the most energy efficient is preferred.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1755

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
October 16, 2006